



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,272	08/28/2000	Peter C. Simpson	18062L-000110	6757

20350 7590 08/27/2002

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BROWN, JENNINE M

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 08/27/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-3

Office Action Summary

Application No.

09/649,272

Applicant(s)

SIMPSON ET AL.

Examiner

Jennine M. Brown

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Sequence Disclosures

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth below or on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Patent applications which contain disclosures of nucleotide and/or amino acid sequences must contain, as a separate part of the disclosure, a paper or compact disc copy (see § 1.52(e)) disclosing the nucleotide and/or amino acid sequences and associated information using the symbols and format in accordance with the requirements of §§ 1.822 and 1.823. This paper or compact disc copy is referred to elsewhere in this subpart as the "Sequence Listing." Each sequence disclosed must appear separately in the "Sequence Listing." Each sequence set forth in the "Sequence Listing" must be assigned a separate sequence identifier. The sequence identifiers must begin with 1 and increase sequentially by integers. If no sequence is present for a sequence identifier, the code "000" must be used in place of the sequence. The response for the numeric identifier <160> must include the total number of SEQ ID NOs, whether followed by a sequence or by the code "000."

A copy of the "Sequence Listing" referred to in paragraph (c) of this section must also be submitted in computer readable form (CRF) in accordance with the requirements of § 1.824. The computer readable form must be a copy of the "Sequence Listing" and may not be retained as a part of the patent application file. If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application if the computer readable form in the other application was compliant with all of the requirements of this subpart. The new application must be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified. In the new application, applicant must also request the use of the compliant computer readable "Sequence Listing" that is already on file for the other application and must state that the paper or compact disc copy of the "Sequence Listing" in the new application is identical to the computer readable copy filed for the other application.

(f) In addition to the paper or compact disc copy required by paragraph (c) of this section and the computer readable form required by paragraph (e) of this section, a statement that the "Sequence Listing" content of the paper or compact disc copy and the computer readable copy are the same must be submitted with the computer readable form, e.g., a statement that "the sequence listing information recorded in

computer readable form is identical to the written (on paper or compact disc) sequence listing."

(g) If any of the requirements of paragraphs (b) through (f) of this section are not satisfied at the time of filing under 35 U.S.C. 111(a) or at the time of entering the national stage under 35 U.S.C. 371, applicant will be notified and given a period of time within which to comply with such requirements in order to prevent abandonment of the application. Any submission in reply to a requirement under this paragraph must be accompanied by a statement that the submission includes no new matter.

Applicant is given THREE MONTHS from the mailing date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under

Art Unit: 1743

the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Dubrow, et al. (US 5976336).

Figures 2a, 2b, 3 and 4 show sequentially loading a multiplexed capillary array electrophoresis apparatus. Dubrow, et al. teach a multiplexed capillary array electrophoresis apparatus and method having multiplexed reservoirs with anodes/cathodes waste and injection areas connected together such that multiple channels cross one another to separate sample electrophoretically (col. 1, l. 50 – col. 22, l. 15).

Examples 1 and 2 teach a method of running samples sequentially on a multiplexed capillary array electrophoresis apparatus (col. 12, l. 33 – col. 14, l. 22).

Claims 1-7 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Simpson, et al. (US 6143152).

US 6143152 teaches a multiplexed capillary array electrophoresis plate having a plurality of separation channels having a plurality of anodes and cathodes, injection channels, waste channels that are collinear with one another.

Double Patenting

Claims 1-7 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-8, 10-13, 15-17, 19-22, 24, 27, 29, 39 of U.S. Patent No. 6,143,152. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a multiplexed capillary array electrophoresis plate having a plurality of separation channels having a plurality of anodes and cathodes, injection channels, waste channels that are collinear with one another. The claims of this application appear to be encompassed by the claims of US 6143152.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (703) 305-0435. The examiner can normally be reached on M-F 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 879-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Application/Control Number: 09/649,272

Page 7

Art Unit: 1743

jmb

August 21, 2002


Jill Warden
Supervisory Patent Examiner
Technology Center 1700